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In re Application of
Ito et al.
Application No.: 10/535,496
PCT No.: PCT/JP2003/014283
Int. Filing Date: 10 November 2003
Priority Date: 18 November 2002
Attorney Docket No.: 0038-0460PUS1
For: Tightening Bandx

DECISION

This is in response to the petition under 37 CFR 1.137(b) and the submission under 37 CFR 1.48(a) (which is being treated under 37 CFR 1.497(d)) filed on 08 April 2008.

BACKGROUND

This international application was filed on 10 November 2003, claimed an earlier priority date of 18 November 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 03 June 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 18 May 2005. Applicant filed *inter alia* the basic national fee on 18 May 2005.

On 22 March 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring an oath or declaration compliant with 37 CFR 1.497(a) and (b).

On 24 April 2006, applicants filed a response, including a declaration.

On 31 August 2006, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, indicating that the declaration "is not executed in accordance with either 37 CFR 1.66 or 1.68."

On 29 September 2006, applicants filed another response, including a declaration.

On 08 February 2008, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to counsel, indicating that this international application had become abandoned with respect to the national stage in the United States for failure to timely reply to the Notification of Missing Requirements mailed on 31 August 2006.

DISCUSSION

Petition Under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed on 08 April 2008 in the above-captioned application is hereby **GRANTED** as follows:

The petition states that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the declaration filed on 08 April 2008, and has paid the petition fee. No terminal disclaimer is required. Thus, the requirements for revival under 37 CFR 1.137(b) have been satisfied.

Petitioner requests a refund of the petition fee, arguing that "in view of the fact that Applicant did timely respond to the Notice of Defective Reply on September 30, 2006 and did not receive any further written communication from the U.S. Patent and Trademark Office, it is respectfully submitted that the present application was not abandoned." Applicant is respectfully advised that the Notification of Defective Response mailed on 31 August 2006 served to advise counsel that the response earlier received on 24 April 2006 was defective, and that it also served to provide applicant with a further opportunity to perfect the required response. Despite this additional opportunity, applicant in fact did not timely provide an oath or declaration compliant with 37 CFR 1.497(a) and (b). Existing policy does not provide for the mailing of a second Notification of Defective Response. Accordingly, the application properly was regarded as abandoned.

Request Under 37 CFR 1.497(d)

Counsel requests correction of inventorship under 37 CFR 1.48(a); however, the appropriate regulation governing this request would be 37 CFR 1.497(d).

Inspection of the declarations filed on 24 April 2006 and 29 September 2006 reveals that they do not nominate the entire inventive entity named in the published international application; instead, they nominate only inventors Ito and Fushimi. Petitioner requests the addition of Fujimori and Yajima as inventors. However, review of the record reveals that the inventive entity named in the international phase consisted of inventors Ito, Fushimi, Yajima and Fujimori, the same inventors who are named in the declaration filed on 08 April 2008. The record does not include any evidence suggesting that a change in inventorship (e.g., pursuant to Rule 92bis) occurred during the international phase. As such, the request under 37 CFR 1.497(d) (brought under 1.48(a)) is moot.

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

The request under 37 CFR 1.497(d) is **DISMISSED AS MOOT**, without prejudice.

This application is being forwarded to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **08 April 2008** (the date that an acceptable declaration under 37 CFR 1.497(a) and (b) was filed).

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